

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 9, 2005. In order to advance prosecution of this case, Applicant amends Claims 1 and 4. Applicant respectfully requests reconsideration and favorable action in this case.

Section 101 Rejections - Claims 1 and 4 Recite Patentable Subject Matter

The Examiner rejects Claims 1 and 4 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Although Applicant believes that these claims are directed to patentable subject matter without amendment, Applicant has amended independent Claim 1 to further clarify that these claims cannot be accomplished “by hand” and are directed to patentable subject matter. Applicant respectfully requests reconsideration and allowance of Claims 1 and 4.

Section 103(a) Rejections

The Office Action rejects Claims 1 and 4 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,633,849 issued to Dodd (“*Dodd*”) in view of Official Notice. Applicant respectfully traverses these rejections for the reasons stated below.

Claim 1 is directed to a method for conducting a transaction, in which a plurality of gift sets are presented to a purchaser. Each of the gift sets includes a plurality of articles, and each gift set may be customized according to a plurality of specific criteria. *Dodd* does not disclose, teach or suggest each of these limitations.

According to the Office Action, *Dodd* discloses the limitation “wherein each gift set may be customized according to a plurality of specific criteria” at column 10, lines 35-51, and column 11, line 4 to column 12, line 67. See Office Action, Page 4. However, this is an improper characterization of the teachings of *Dodd*.

Dodd discloses that “the user may want to customize or personalize delivery of the gift by adding an audio and/or video message to announce the greeting or add a personalized text message.” See *Dodd*, Column 11, lines 34-38 (emphasis added). Thus, *Dodd* contemplates customization of the delivery of the gift, but not customization of a gift

(or gift set). For at least these reasons, Applicant respectfully contends that Claim 1 is patentably distinguishable from *Dodd*.

Claim 4 depends from Claim 1 and includes the additional limitation “receiving at least one of the specific criteria regarding the selection from the recipient.” According to the Office Action, *Dodd* discloses “receiving at least one of the specific criteria... from the purchaser.” See Office Action, Page 4 (emphasis added). Even if this is true, the Office Action contends that the criteria is received from the purchaser in *Dodd*, and not the recipient, as contemplated by Claim 4. For at least these reasons, Applicant respectfully contends that Claim 4 is patentably distinguishable from *Dodd*.


Conclusions

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Applicant believes no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. **02-0384** of **Baker Botts L.L.P.**

Respectfully submitted,

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